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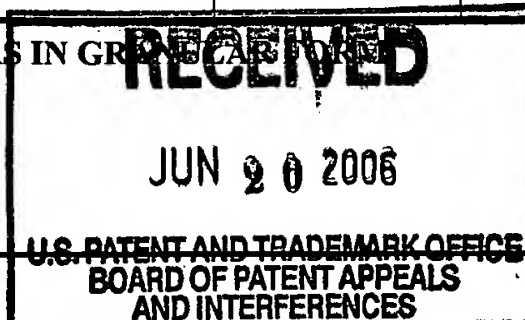
TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.  
GRLK-P121-US

In Re Application Of: Carlo Neri

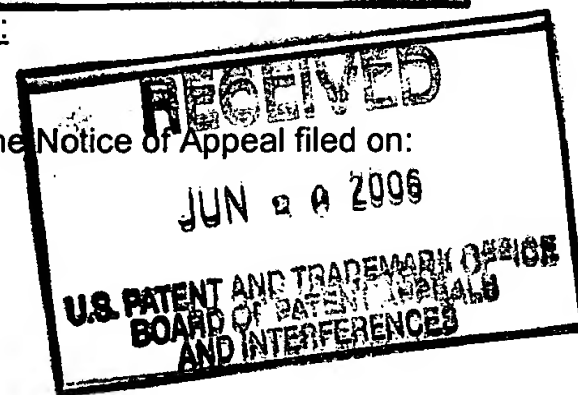
Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/692,025	October 19, 2000	Joseph David Anthony	27268	1714	5441

Invention: MIXTURES OF ADDITIVES FOR ORGANIC POLYMERS IN GREEN CARBON



COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:



The fee for filing this Appeal Brief is: \$0.00

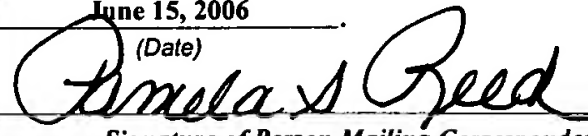
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Signature

Dated: June 15, 2006

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JUN 20 2006

Application No.

09/692,025

Filing Date

October 19, 2000

Examiner

Joseph David Anthony

Customer No.

27268

Group Art Unit

1714

Confirmation No.

5441

Invention: MIXTURES OF ADDITIVES FOR ORGANIC POLYMERS IN GRANULAR FORM

COMMISSIONER FOR PATENTS:

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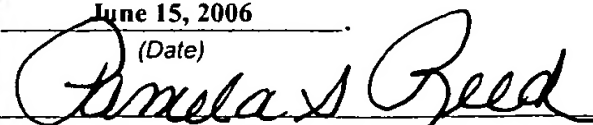
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/692,025 Confirmation No. 5441  
Applicant : Carlo Neri  
Filed : October 19, 2000  
TC/A.U. : 1714  
Examiner : JOSEPH DAVID ANTHONY  
TITLE : MIXTURES OF ADDITIVES  
FOR ORGANIC POLYMERS IN  
GRANULAR FORM  
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Customer No. : 27268

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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June 15, 2005

By: Pamela S. Reed  
Pamela S. Reed

REPLY BRIEF

Applicant submits his Reply Brief in appeal of the *ex parte* patent application referenced above responding to the Corrected Examiner's Answer dated May 16, 2006. This Reply Brief replaces in its entirety the Reply Brief previously submitted August 1, 2005.

**Corrected Claims Appendix**

In the course of preparing the initial Reply Brief submitted August 1, 2005, applicant identified errors in the claims as submitted in the Claims Appendix that occurred during the course of prosecution that have carried forward.

The identified errors are in claim 2 and in claim 11.

In an amendment to claim 2 in response to the First Office Action, the word "phosphite" appearing in the patent application as filed was changed to "phosphate". No explanation or comment accompanied the amendment addressing this change. The change was not accompanied with strike-through or underlining according to 37 CFR §1.121(c)(2).

In the same amendment, the term "methine" in claim 11 became "methane". Again, no explanation or comment accompanied the amendment addressing this change. The change was not accompanied with strike-through or underlining according to 37 CFR §1.121(c)(2).

Applicant submits that in each case these changes are errors and were not intended to be amendments to the claims.

Attached to this Reply Brief is a Corrected Claims Appendix wherein the errors referenced above are corrected.

Although it may be unusual at the stage of appeal that such errors be addressed, applicant requests that the Corrected Claims Appendix be considered and adopted as the claims on appeal.

Applicant notes with appreciation the acknowledgement by the Examiner in the corrected Reply Brief dated May 16, 2006, p. 4, that the previously noted correction, also attached hereto, contains the corrected copy of the claims under appeal.

**I. Rejection of Claims 1–6, 8–14, and 18–21 for Lack of Written Description, 35 USC §112, First Paragraph**

The Reply Brief argues Applicant's specification as filed does not disclose that Applicant was in possession of the limitation "said mixture being devoid of said organic polymers and carriers for said components" at the time the application was filed. The only support in the record for the rejection is the statement:

Applicant's assertion that the specification on page 3, lines 11-21, enables such a sweeping negative limitation is not accepted by examiner. The said specification section is silent on the present [sic, presence] of a polymer in applicants' invention. this silent[ sic, silence] is not to be expanded to positively exclude such polymers.

Corrected Examiner's Answer, 5/16/2006, p. 5–6.

The identical text appears in the Office Action 6/16/2004, at page 2 and represents the entire analysis on which claims 1-6, 8-14, and 18-21 were rejected pursuant to 35 USC §112.

First Paragraph.

**A. The Patent Office Standard for Examination of Claims for Descriptive Support pursuant to 35 USC §112, First Paragraph**

Examination standards established by the Patent and Trademark Office place on the examiner "the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims." Guidelines for Examination of Patent Applications Under the 35 U.S.C.112, 1, "Written Description" Requirement, 66 Federal Register 1099-1111, January 5, 2001.

The purposes behind the 'written description' requirement is described in the *Guidelines* as:

to clearly convey the information that an applicant has invented the subject matter which is claimed, . . . to put the public in possession of what the applicant claims as the invention. . . . ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

*Id.* at 1104.

The examination of patent claims for compliance with 'written description' requirement

calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed and should include a determination of the field of the invention and the level of skill and knowledge in the art.

*Id.* at 1105.

The record in the instant matter does not disclose that the prescribed guidelines were followed: There is no indication in the examination record of consideration of the state of the art; there is no indication in the examination record of whether the public is placed in possession of the invention claimed.

While the *Guidelines* are guidelines, not rules, and do not have legal force,<sup>1</sup> the Commissioner states in the Federal Register publication that it

"is believed to be fully consistent with binding precedent of the U.S. Supreme Court, as well as the U.S. Court of Appeals for the Federal Circuit and its predecessor courts."

Id. at 1104.

Whether the *Guidelines* have the force of law or not, they establish performance standards that applicants may expect for examination of patent applications. This record does not show compliance with this performance standard.

**B. The Judicial Standard for Compliance with the 'Written Description' Requirement of 35 USC §112, First Paragraph**

Compliance with the written description requirement is fact based. *Enzo Biochem v Gen-Probe* 323 F.3d. 956, 962-63, 63 USPQ2d 1609, 1612 (Fed.Cir., 2002); *Invitrogen Corp. v Clontech Laboratories, Inc.*, 429 F.3d 1052, 1072, 77 USPQ2d 1161, 1175 (Fed.Cir., 2005); *Falkner et al v Inglis et al.* slip opinion p. 8 , (Fed. Cir., May 26, 2006).

In *In re Wertheim* 541 F.2d 257, 191 USPQ 90, (CCPA, 1976) the court stated the question as one of fact: "is the compound of claim 13 described therein? Does the specification convey

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<sup>1</sup> "Guidelines", 66 FR at 1104. *Enzo Biochem v Gen-Probe* 323 F.3d. 956, 964, 63 USPQ2d 1609, 1613 (Fed.Cir., 2002).

clearly to those skilled in the art, to whom it is addressed, in any way, the information that appellants invented that specific compound?" *Id.* 541 F.2d at 263, 191 USPQ 97.

Text from the *Guidelines* was judicially adopted as a test for 'written description' in *Enzo Biochem, supra* 323 F.3d at 964, 63 USPQ2d at 1613.

The challenged broad claim which is the subject of this appeal with emphasis of the alleged offending amendment reads:

1. (Previously Amended) A mixture of additives for organic polymers in granular form comprising:

- one or more stabilizers for organic polymers; plus
- one or more organic or inorganic pigments; and/or
- one or more dyes or bleaching agents;

obtained by extrusion at a temperature capable of enabling the partial or total melting of the lowest-melting of said components, the molten part of which, on solidifying, act as gluing agent for the remaining components,

said inorganic pigments being selected from the group consisting of iron oxides, carbon black, talc, China clay, barites, silicates, and sulfosilicates;

said mixture being devoid of said organic polymers and carriers for said components.

Applied to the claims under consideration, the test for compliance with the 'written description' requirement may be stated: 'Does the specification convey to those skilled in the art, to whom it is addressed, in any way, the information that applicant possessed and conveyed to those skilled in the art the formation of a mixture for additives for organic polymers "devoid of said organic polymers and carriers for said components".' *Id.*

This question is answerable from the specification and the state of the art as to what was considered conventional by those skilled in the art at the priority date. *Id.* 541 F.2d at 264, 191 USPQ at 98.

The state of the art, as represented by the references of record demonstrates efforts to reduce dust associated with polymer compounding by the use of binders (US 5,455,288), precipitates from aqueous solution (US 5,888,524), a solid of additives dried from an aqueous solution (US 4,729,796), or spray dried mixture from an aqueous solution (US 5,437,688). The state of the art described in the specification includes the masterbatch and carriers.

### **C. Written Description Supporting the Claim Amendment**

Example 1 of the specification<sup>2</sup> describes the extrusion of mixture of (1) an antioxidant;<sup>3</sup> (2) and a second antioxidant;<sup>4</sup> (3) calcium stearate; (4) a pigment, dye, or bleaching agent.<sup>5</sup> No

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<sup>2</sup> Specification p. 37.

<sup>3</sup> Specification, p. 9, lines 5–7.

<sup>4</sup> Specification, p. 18, lines 10–14.

<sup>5</sup> Ultramarine violet is an inorganic pigment having the elemental composition of  $2(\text{Na}_2\text{Al}_2\text{Si}_2\text{O}_6) \cdot \text{NaS}_2$ . See Exhibit A, G. Montagna, *I Pigmenti*, p. 163, copy attached.

Applicant provides the attached Exhibit A as text book support in this Reply Brief in rebuttal of an argument in the Corrected Examiner's Answer.

Applicant is not unaware that the Board has previously applied 37 CFR § 41.41(a)(2) as a basis to disregard support provided in a Reply Brief.

If the Board asserts, that the Board may by adoption of a rule, restrict the Applicants' freedom to fully respond to an unwarranted position by the Examiner, then applicants submit that the Board's rule 37 CFR § 41.41(a)(2), as applied, is constitutionally infirm. "When government agencies adjudicate or make binding determinations which directly affect the legal rights of individuals, it is imperative that those agencies use procedures which have traditionally been associated with the judicial process." *Hanna v. Larche*, 363 U.S. 420, 442 (1960).

Applicants submit that at a minimum, 'procedures traditionally associated with the judicial process' includes a right to fully respond to the Corrected Examiner's Answer. Any hint or suggestion that a patent applicant may not respond including reference to a supporting textbook source, by adoption of a rule or procedure, denies due process to the patent applicant.



organic polymer is disclosed. Upon extrusion, a 'spaghetti' is obtained. Example 1 then demonstrates Claim 1, including the absence of organic polymer.

While it may not have the force and effect of law, the Patent and Trademark Office declared in response to comments concerning Proposed Guidelines that "Description of an actual reduction to practice offers an important "safe haven" that applies to all applications and is just one of several ways by which an applicant may demonstrate possession of the claimed invention." Guidelines, *supra* at 1102. Having described an example of the invention that does not include an organic polymer, applicant submits that at least so far as prosecution in the Patent and Trademark Office is concerned, that the *Guidelines* provide a 'safe haven' for the claim amendment at issue.

Looking to the judicial standard of whether the skilled artisan is placed in possession of the invention as claimed, Example 1 of the Specification satisfies the test. The artisan need only look to the Example to see that by extrusion at the temperature profile disclosed the components may be glued to a dust-free solid. In addition, the specification provides at page 35-36 that:

The present invention also relates to polymeric compositions containing a organic polymer and an effective quantity of one of the above mixtures of additives. The mixtures of additives, object of the present invention, are particularly useful in the stabilization and dyeing of organic polymers selected from those listed above.

Page 35, line 22 – page 36, line 3.

the mixtures of additives . . . obtained by the extrusion at a temperature capable or enabling the partial or total melting of the lowest-melting component.

Page 3, line 25 – p. 4, line 6.

By 'mixture of additives', the specification describes: stabilizers for organic polymers; organic or inorganic pigments; and/or one or more dyes. Organic polymers are not among the 'mixture of additives'.

Applicant submits it is beyond peradventure that the specification satisfies the 'written description' test of 35 USC §112, First Paragraph.

**D. Claims Suggested by the Corrected Examiner's Answer**

The Corrected Examiner's Answer would limit applicant's amendment to claim 1 to exclusion of the same polymer as the polymer to which the additive will be added. Corrected Examiner's Answer, 5/16/2006, p. 9. Applicant does not accept this reading. Moreover, whether the reading suggested is correct, or not, is irrelevant to the rejection for lack of compliance with the written description requirement. The proper test is whether the person of ordinary skill in the art is informed that applicant invented the claimed invention as of the filing date. *In re Wertheim* 541 F.2d at 263, 191 USPQ at 97 (CCPA, 1976).

The Examiner's Answer suggests what applicant should have claimed.

The examiner holds that if applicants had really originally intended to positively exclude polymers from [sic, from] their additive mixture they would have made an explicit statement to such in the specification. . .

Corrected Examiner's Answer, 5/16/2006, p. 9.

The *Guidelines* incorporate a comment to the proposed rules strikingly similar to the position taken above in the Corrected Examiner's Answer concerning what applicant "would have" done. A public member concerned about the Proposed *Guidelines* commented:

[T]he examiner may decide what applicant should have claimed and reject the claim for failure to claim what the examiner considers to be the invention.

Guidelines, p. 1099

The Patent and Trademark Office responded to the comment:

The suggestions have been adopted in part. The purpose of the written description analysis to confirm that applicant had possession of what is claimed. The Guidelines have been modified to instruct the examiners to compare the scope of the invention claimed with the scope of what applicant has defined in the description of the invention. That is, the Guidelines instruct the examiner to look for consistency between a claim and what provides adequate factual support for the claim as judged by one of ordinary skill in the art from reading the corresponding written description.

Guidelines, p. 1100.

One may conclude therefore, that the examiner's inclination as to what applicant may have, could have, should have, claimed is irrelevant. The examiner's conception of applicant's 'intent' has no role in the question of whether applicant provided written description for the claim, as amended.

*In re Wertheim, supra.*

**E. Distinguishing Applicant's Claims to a Mixture of Additives from a Masterbatch**

The Corrected Examiner's Answer urges that the appropriate construction of applicant's claim, as amended, is "the broadest reasonable interpretation". Corrected Examiner's Answer, p. 10. As with all positions taken in the Corrected Examiner's Answer, no authority therefore is provided. Applicant submits that the improper result reached in the Corrected Examiner's Answer may in part be attributed to the application of the wrong test. The appropriate scope to be applied to claims during examination of patent examination requires that the 'broadest reasonable interpretation' be construed as it would be understood by 'one of ordinary skill in the

art'. *In re Morris et al.* 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed.Cir., 1997).

(emphasis supplied). Whether this examiner meets the definition of one of ordinary skill in the art or not, the point by applicant in the Appeal Brief is that applicant's claims were readily understood by the examiner as not being a masterbatch, based on the specification and therefore should meet the test of *In re Wertheim*.

#### **F. Temperature Limits**

The Corrected Examiner's Answer urges that applicant's claims do not include an upper temperature limit. p. 11. Further that as a consequence of not providing an upper temperature limit, applicant has not excluded a masterbatch from the claim. Applicant does not accept that an upper temperature is required to distinguish the instant claims from prior art describing a masterbatch.

Applicant notes that the instant claims provide that a temperature sufficient to melt the lowest melting of said components. 'Said components' being stabilizer, pigment, dye or bleaching agent. The claims further provide that the remaining components are 'glued' by the lowest melting of said components. In addition, no prior art of record relates to a masterbatch.

#### **II. Rejection of Claims 1–6, 8–14, and 18–21 for Anticipation Based on 35 USC §102 (b).**

The Corrected Examiner's Answer urges that Applicant's claims are in a form that requires a showing by Applicant of "distinctiveness, criticality, superior or unobvious results that may or may not occur to applicant's claimed product when it is made by applicants' process."

Corrected Examiner's Answer, p. 11–12. As with other legal arguments in the Corrected Examiner's Answer, no authority is presented for this proposition. It is appropriate that no authority is cited by the Corrected Examiner's Answer, as no sound authority supports the argument stated.

**A. Applicable Law of Anticipation**

To reject claims as anticipated, each, and every claim limitation must be found in a single prior art reference.

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.

*In re Paulsen* 30 F.3d 1475, 1478-0, 31 USPQ2d 1671, 1673 (Fed.Cir., 1994).

The instant claims are product claims, including process steps. Thus, anticipation requires that if a prior art product is made by a different process, that the product of the instant claims be 'the same as' the prior art product. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964(Fed.Cir., 1985).

If the product in a product-by-process claim is the same as . . . a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.  
Supra, 777 F.2d at 697, 227 USPQ at 966.

The test of anticipation is whether the product of the claim "is the same as . . . a product from the prior art". *SmithKline Beecham Corp. v Apotex Corp.* 439 F.3d 1312, 1317, 78 USPQ2d 1097, 1101 (Fed.Cir., 2006). Applicants claims are limited to a melt of the lowest melting of the additive mixture. As is apparent from the review of the prior art of record, none

of the applied art discloses melting of the lowest melting component of applicant's claimed mixture.

The assertion in the Examiner's Brief that the applicant must show "distinctiveness, criticality, superior or unobvious results" is misplaced, unsupported, and wrong.

**B. Applied Prior Art US 5,455,288 to Needham**

The first substantive Office Action and Examiner's Answer urges Example 1 of the '288 reference discloses a product that anticipates the claimed invention.

Example 1 of '288 discloses pigment, particulated resin, binder, zinc stearate, UV stabilizer and antioxidant. Col. 5, lines 51–55. The ingredients are blended with temperature increased to 150°F. The role of the binder is disclosed at Col. 5, lines 3–10.

Advantageously, the degree of agitation and blending time are selected to ensure adequate mixing of the binder, pigment and other constituents, and sufficient heat to produce a dustless, mix. When friction heat is used, a uniform mixture is generally produced **by the time the binder melts**. Typically a commercially available ribbon blender can handle a batch up to about 500 pounds in about 30 minutes or less.

'288, Col. 5, lines 3–10 (emphasis added).

Additional references to the role of the binder include Col. 3, lines 36–49; Col. 4, lines 56–58.

The '288 reference discloses a means of generating a dustless combination that requires the presence of a 'binder' to produce "a dustless mixture of individual resin particles coated with pigment and binder". (Col. 2, lines 13–14). The Corrected Examiner's Answer Specifically references Examples 1, and 2 of the '288 reference. For each example, a binder is required.

"The binder is a fatty acid amide commercially available as Kemamide "E" from Witco, Chemically known as erucamide." (Col. 5, lines 58–61.)

Applicant's independent claim 1 concerns:

. . . one or more stabilizers for organic polymers; plus one or more organic or inorganic pigments; and/or one or more dyes or bleaching agents; obtained by extrusion at a temperature capable of enabling the partial or total melting of the lowest-melting of said components, the molten part of which, on solidifying, act as gluing agent for the remaining components . . . .

Thus in applicant's claims, it is one of: stabilizers, or pigments, or dyes, or bleaching agents that is "the lowest-melting of said components". The instant claims provide that it is the "lowest-melting of said components . . . [that] act as gluing agent for the remaining components". There is no teaching in the '288 reference that the 'binder' is a stabilizer, a pigment, a dye, or a bleaching agent as the terms are used in the instant claims. While the '288 reference may describe "granules including individual resin particles beneficially coated with binder and pigment" (Col. 1, lines 64–66), no office action, nor the Corrected Examiner's Reply, has identified a teaching in the '288 reference where the gluing agent is one of: stabilizers, or pigments, or dyes, or bleaching agents according to applicant's claims.

The Corrected Examiner's Answer would add to the previous arguments that the '288 reference anticipates because a polymer different from the matrix polymer is coated with additives in '288, Example 1. The argument is not accepted by applicant and moreover is irrelevant to the rejection for anticipation. No teaching or suggestion has been identified in the '288 reference that any polymeric additives, as claimed, is melted. Rather, a "binder" erucamide, serves to glue the components to a polymer.

The '288 reference does not describe a product which "is the same as" the claimed invention. Consequently the rejection of claims as anticipated by the '288 reference is improper, finds no support in the record, and must be reversed.

**C. Applied Prior Art US 5,888,254 to Gäng et al.**

The first substantive Office Action urges all examples of the '254 reference anticipate the claimed invention. The Final Office Action is likewise no more specific. The Examiner's Answer for the first time specifies example 8 as anticipating the claimed invention.

The '254 example 8 discloses the preparation of granules from an aqueous solution of 23wt% dye, and 5wt% NaOH and ascorbic acid. Following the process of example 7 referenced by example 8, the components are apparently precipitated from aqueous solution, and concentrated to dryness at 120°C and under vacuum. The Examiner's Answer states Example 8 contains anticipating disclosure including "2) sodium hydroxide (reads on applicants' claimed stabilizer component of claim 1, . . . )".

Applicant finds hydroxides mentioned on p. 21 of the specification, line 4, among a listing of "Fillers and reinforcing agents". Notwithstanding the statement in the Corrected Examiner's Answer, applicant does not find sodium hydroxide identified among the description of the claimed "stabilizers for organic polymers". If it is the position taken in the Examiner's Answer that sodium hydroxide is a 'stabilizer' notwithstanding that it is not included as a stabilizer in applicant's specification, then no reference supports the proposition, and no support according to 37 CFR §1.104(d)(2) is provided.



Moreover, no reference is made to a melt of one of: stabilizers, or pigments, or dyes, or bleaching agents that is "the lowest-melting of said components", or to gluing with said melt of other components

Accordingly, the '254 reference does not describe a product which "is the same as" the claimed invention. Consequently the rejection of claims as anticipated by the '254 reference is not supported by the record, improper and must be reversed.

**D. Applied Prior Art US Patent 4,729,796 to Deubel et al.**

The substantive office actions and the Corrected Examiner's Answer identify example 1 of the '796 reference as anticipating applicant's claims.

Example 1 discloses preparation of a granulate comprising a pigment, a resin, and an antioxidant component. The components are in an aqueous solution prior to forming a granular material. This '796 reference also appears to form a precipitate from a solution. The resin, colophony (softening point 73°C), is soluble in water and also present in the mixture. Col. 1, lines 38–39. The granular material is dried after filtering off the water.

The instant claims do not admit a "carrier". Colophony is defined as "[a] rosin residue that remains after the volatiles have been removed by distillation of crude turpentine from any of the *Pinus* species."<sup>6</sup>

The '796 reference provides a granule of pigment, carrier, and antioxidant is obtained as a solid from the liquid solution. In contrast, the instant claims call for one of stabilizers, pigments, dyes or bleaching agents to "act as a gluing agent for the remaining components". So far as applicant can determine, a gluing agent is not identified in the '796 reference that is a stabilizer, a

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<sup>6</sup> Hawley's Condensed Chemical Dictionary, 14<sup>th</sup> ed., John Wiley & Sons, Inc., New York, 2001.

pigment, a dye, or a bleaching agent according to applicant's claims. The Office Action and the Examiner's Answer do not identify a gluing agent, or discuss how the particulate of '796 is bound. Assuming for the sake of argument that binding is supplied by colophony, colophony is not among the stabilizers for organic polymers, organic or inorganic pigments; or dyes or bleaching agents of applicant's claims. Accordingly, the '796 reference does not describe a product which "is the same as" the claimed invention. Consequently the rejection of claims as anticipated by the '796 reference is improper, not supported by the record, and must be reversed.

**E. Applied Prior Art U.S. Patent 5,437,688 to Yamanuchi et al.**

The rejection of pending claims in the first substantive Office Action and the Final Office Action, was supported by reference to all examples of the '688 reference. The original Examiner's Answer and now the Corrected Examiner's Answer, for the first time points to example 1 as anticipating the pending claims. Example 1 discloses 1) an aqueous dye solution; 2) sodium primary phosphate; 3) anhydrous sodium sulfate; 4) an alkyl ester comprising 34 carbon atoms; and 5) a derivative of 3,4-dihydroxy  $\gamma$ -pyran ('688, formula 4, Col. 6, line 55). For the first time in this prosecution the Corrected Examiner's Answer urges that "sodium primary phosphate (reads at least on applicant's stabilizer component of claim 1)". (Examiner's Answer, p. 8). The specification describes 'phosphates' among nucleating agents. (p. 20, lines 17-25).

As noted above in this Reply Brief, an error in amending claim 2 in the first substantive Response filed March 25, 2004 was carried forward and included by Applicant in his Statement of Claims with this appeal. This error may be the source of some confusion on the part of the

Examiner. Applicant's first recognition of this error occurred in the preparation of the initial Reply Brief filed August 1, 2005.

Dependent claim 2 as initially presented included the components "stabilizers for organic polymers are selected from the following groups: antioxidants, ultraviolet-ray and light stabilizers, metal-deactivators, *phosphites* and phosphonites, hydroxylamines, . . . ." (italics added). Dependent claim 2 was amended with the response of March 25, 2004 in other respects. Amendments were identified consistent with 37 CFR §1.121(c)(2) by underlines and strike-through of characters. In the course of preparing dependent claim 2 for the March 25, 2004 amendment, the component "*phosphites*" became "*phosphates*". The change from phosphites to phosphates was not characterized according to Rule 121. No comment addressing changes to dependent claim 2 was included with the response. Applicant submit the change of claim language was unintentional and that claim 2 should not include the term "phosphate".

Since applicant's (correctly presented) claims do not characterize "phosphates" among stabilizers for organic polymers, the characterization in the Corrected Examiner's Answer of "sodium primary phosphate" as reading on applicant's stabilizer component is erroneous. If the mentioned typing error resulted in a misapprehension of applicant's description of stabilizers for organic polymers, then applicant apologizes for the inconvenience.

Alternatively, if the thrust of the Examiner's Answer is to urge that 'phosphates' are stabilizers for organic polymers, then applicant notes no support for the proposition as identified in any reference of record by any office action.

Anhydrous sodium sulfate is urged by the Corrected Examiner's Answer to "(read[] at least on applicants' claimed rheological agent of claim 5)". Corrected Examiner's Answer, p. 8.

Applicant describes inorganic sulfates as nucleating agents. (p. 20, lines 17–20). So far as applicant can determine, the specification includes no description of sulfates as 'rheological agent'. No reference of record equates sulfates as 'rheological agents'. If facts within the personal knowledge of the examiner or other employees of the office are relied upon (37 CFR §1.104(d)(2)), such facts are not of record.

Further, the Corrected Examiner's Answer applies the sulfate component of the '688 reference to a component of a dependent claim. If the independent claim is novel, correspondence of a component of a dependent claim with the prior art does not anticipate the dependent claim. *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n. 9, 1553, 10 USPQ2d 1201, 1207 n. 9, 1208 (Fed.Cir.1989)

Distinguishing the instant claims from the '688 reference is the gluing action of the lowest-melting of a stabilizer, pigment, dye or bleaching agent. The granule prepared according to '688 reference, example 1, is spray dried. Col. 9, lines 46–48. No office action has identified, nor does the Examiner's Reply identify a disclosure of melted portion of any component of the '688 reference. No office action, nor the Examiner's Answer, identifies a disclosure of melting the lowest melting of a stabilizer, pigment, dye or bleaching agent component to 'act as a gluing agent for the remaining components' in the '688 reference.

The '688 reference does not describe a product which "is the same as" the claimed invention. Consequently the rejection of claims as anticipated by the '688 reference is improper and must be reversed.

### **III. Summary**

The examination record discloses that the examination has not compared the pending claims with the appropriate legal standard for compliance with the 'written description' requirement of 35 USC §112, Second Paragraph. That when tested against the appropriate legal standard, applicant's pending claims not only meet fully the 'written description' requirement, but may be found moored with in a 'safe harbor' thereof.

Applicant exercised applicant's prerogative afforded by *Autogiro Company of America v United States* 394 F.2d 391, 397, 155 USPQ 697, 702 (Ct.Cl. 1967) to serve as his own lexicographer. No prior art of record discloses 'a mixture of additives for organic polymers in granular form' having the lowest melting of stabilizers for organic polymers, organic or inorganic pigments, or dyes or bleaching agents acting as a gluing agent for the remaining components. The specification provides meaning to the claim terms: 'stabilizers for organic polymers', 'organic pigment', inorganic pigment', 'dyes', and 'bleaching agents'. Attribution by the Corrected Examiner's Answer of 'binders' (Corrected Examiner's Answer, p. 12) to applicant's claim elements is without support in the specification, or claims, and without legal authority.

No reference of record discloses a product which 'is the same as' applicant's invention as claimed.

For the reasons aforesaid, applicant is entitled to the Relief Requested.

### **IV. Relief Requested**

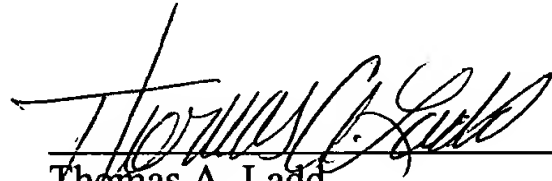
Applicant seeks:

- 1) withdrawal of the 'written description' rejection pursuant to 35 USC §112, First paragraph;

- 2) withdrawal of all anticipation rejections pursuant to 35 USC §102(b) over all references of record;
- 3) correction of the claims according to the Amended Claims Appendix submitted with this Reply Brief; and
- 4) appropriate extension of the patent term from the ordinary term of 20 years from filing date 35 USC §154(a)(2), resulting from the delay caused by this appeal.

35 USC §154 (b)(1)(C)(iii).

*15 June 2006*

  
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AMENDED CLAIMS APPENDIX

1. (Previously Amended) A mixture of additives for organic polymers in granular form comprising:

- one or more stabilizers for organic polymers; plus
- one or more organic or inorganic pigments; and/or
- one or more dyes or bleaching agents;

obtained by extrusion at a temperature capable of enabling the partial or total melting of the lowest-melting of said components, the molten part of which, on solidifying, act as gluing agent for the remaining components,

said inorganic pigments being selected from the group consisting of iron oxides, carbon black, talc, China clay, barites, silicates, and sulfosilicates;

said mixture being devoid of said organic polymers and carriers for said components.

2. (*Corrected*)(Previously Amended) The mixture of additives in granular form according to claim 1, wherein the stabilizers for organic polymers are selected from the group consisting of: antioxidants, ultraviolet-ray and light stabilizers, metal-deactivators, ~~phosphates~~ phosphites and phosphonites, hydroxylamines, nitrons, thiosynergizing agents, agents capable of destroying peroxides, polyamide stabilizers, basic co-stabilizers, nucleating agents, fillers and reinforcing agents, benzofuranones and indolinones.

3. (Previously Amended) The mixture of additives in granular form according to claim 2, wherein the antioxidants are selected from the group consisting of alkylated monophenols,

alkylthiomethylphenols, hydroquinones and alkylated hydroquinones, tocopherols, hydroxylated thiodiphenyl ethers, alkylidenebisphenols, benzyl compounds containing O, N or S, hydroxybenzylated malonates, aromatic hydroxybenzyl compounds, triazine compounds, benzylphosphonates, acylaminophenols, esters of  $\beta$ (3,5-di-t-butyl-4-hydroxyphenyl)propionic acid with monohydric or polyhydric alcohols, esters of  $\beta$ -(5-di-t-butyl-4-hydroxyphenyl)propionic acid with monohydric or polyhydric alcohols, esters of  $\beta$ -(3,5-dicyclohexyl-4-hydroxyphenyl) propionic acid with monohydric or polyhydric alcohols, esters of 3,5-di-t-butyl-4-hydroxyphenyl acetic acid with monohydric or polyhydric alcohols, amides of  $\beta$ -(3,5-di-t-butyl-4-hydroxyphenyl)propionic acid, ascorbic acid, and aminic antioxidants.

4. (Previously Amended) The mixture of additives in granular form according to claim 2, wherein the ultraviolet ray and light stabilizers are selected from the group consisting of derivatives of 2-(2'-hydroxyphenyl)benzotriazoles, derivatives of 2-hydroxybenzophenones, esters of benzoic acids optionally substituted, acrylates, nickel compounds, sterically hindered amines and their N-alkoxy derivatives, oxamides, and 2-(2-hydroxyphenyl)-1,3,5-triazine.

5. (Previously Amended) The mixture of additives in granular form according to claim 2, wherein other additives are present selected from the group consisting, of plasticizers, lubricants, emulsifying agents, rheological additives, catalysts, slip agents, optical brighteners, flame-retardants (bromurates, chlorurates, phosphorates and phosphorous/halogen mixtures), antistatic agents, and blowing agents.



6. (Previously Amended) The mixture of additives in granular form according to claim 1, wherein the organic pigments are selected from the group consisting of organic pigments of the azo type, azomethines, anthraquinones, perilenes, dioxazines, thioindigo reds, quinacridones, phthalocyanines, blue indanthrones, carbazoles, isoindolinones, isoindolones, benzimidazolinones, and their metal salts.
7. (Cancelled)
8. (Previously Amended) The mixture of additives in granular form according to claim 1, wherein the dyes or bleaching agents, are soluble, insoluble or slightly soluble in water.
9. (Previously Amended) The mixture of additives in granular form according to claim 8, wherein the dyes which are soluble in water are selected from the group consisting of acid dyes, aminoketones, ketone-imines, methines, nitrodiphenylamines, quinolines, aminonaphthoquinones, coumarins, anthraquinones, and azo dyes .
10. (Previously Amended) The mixture of additives in granular form according to claim 9, wherein the dyes which are soluble in water contain one or more anionic groups soluble in water.
11. (*Corrected*)(Previously Amended) The mixture of additives in granular form according to claim 8, wherein the dyes are soluble in water are selected from the group consisting of salts, metal halides, anthraquinones, phthalocyanines, diarylmethane and triarylmethane; ~~methane~~ methine, polymethine and azomethine; thiazoles, ketone-imines, acridines, cyanines, nitro dyes,

quinolines, benzimidazoles, xanthenes, azines, oxazines, thiazines and triazines which have at least one quaternary nitrogen in the molecule.

12. (Previously Amended) The mixture of additives in granular form according to claim 1, wherein the dyes which are insoluble or slightly soluble in water are selected from the group consisting of dyes containing sulfur, disperse dyes and vat dyes.

13. (Previously Amended) The mixture of additives in granular form according to claim 12, wherein the disperse dyes are selected from the group consisting of nitro dyes, aminoketones, ketone-imines, methines, polymethines, diphenylamines, quinolines, benzimidazoles, xanthene, oxazines, aminonaphthoquinones, and coumarins which do not contain carboxylic acid or sulfonic acid groups.

14. (Original) The mixtures of additives in granular form according to claim 12, wherein the vat dyes are those applied to fabrics in dispersed solid form and, after development, are still present in a form which is insoluble in water.

15. (Previously Withdrawn) Use of the mixtures of additives according to any of the previous claims in the stabilization and dyeing of organic polymers.

16. (Previously Withdrawn) Polymeric compositions containing an organic polymer and an effective quantity of one of the mixtures of additives according to any of the previous claims.

17. (Previously Withdrawn) End-products obtained from the processing of the polymeric compositions according to claim 16.

18. (Previously Added) The mixture of claim 10, wherein said anionic groups soluble in water are selected from the group consisting of carboxylic acid groups, sulfonic acid groups, and salts of said carboxylic and sulfonic acid groups.
19. (Previously Added) The mixture of claim 18, wherein said salts are selected from the group consisting of lithium, sodium, potassium and ammonium salts.
20. (Previously Added) The mixture of claim 11, wherein said salts which are dyes soluble in water are selected from the group consisting of chlorides, sulfates, metasulfates and -- onium chlorides, and said metal halides which are dyes soluble in water are tetrachlorozincates of azo dyes.
21. (Previously Added) The mixture of claim 13, wherein said disperse dyes are selected from the group consisting of anthraquinones and azo dyes.

GIOVANNI MONTAGNA

# I PIGMENTI

PRONTUARIO  
PER L'ARTE E IL RESTAURO

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*TP936*  
*- M65*  
*1993*

*AD*



NARDINI EDITORE

EXHIBIT "A" Page 1 of 2

A  
nto

GRUPPO: VIOLA

SCHEDA 163

Violetto oltremare

INDICE DI RIFRAZIONE: 1,55  
POTERE COPRENTE: \*\*\*  
COMPOSIZIONE E FORMULA CHIMICA  
colorato con ossido di manganese

+ MnO  
ELEMENTO O IONE DA CONFERMARE  
nessuno  
AZIONI: Fondo ad alte temperature

STABILITÀ: Inalterato in acidi e basi  
ALLA LUCE: \*\*\*\*\*  
ALLA TEMPERATURA: \*\*\*\*\*  
ALL'UMIDITÀ: \*\*\*\*\*  
ALLA CALCE: \*\*\*\*\*  
CHIMICA: \*\*\*\*\*

PREPARAZIONE: Vetro colorato con ossido di manganese, macinato con  
e portato a fusione in crogioli  
lo da formare una massa vu

NOME: Violetto oltremare  
- Violet outremar (fr.), Ultramarine Violet (ingl.)

#### NOTIZIE STORICHE

ORIGINE: 1840  
EPOCHÉ D'USO: XIX secolo

#### CAMPI DI UTILIZZAZIONE

AFFRESCO: Sì                      ENCAUSTO: No  
TEMPERA: Sì                      OLIO: No

#### CARATTERISTICHE CHIMICO-FISICHE

ORIGINE:  
Minerale                      Inorganica  
COLORI DI INTERFERENZA: No  
PESO SPECIFICO: 2,34

ASSORB. AI RAGGI X: \*\*\*

INDICE DI RIFRAZIONE: 1,64

POTERE COPRENTE: \*\*\*

COMPOSIZIONE E FORMULA CHIMICA:  
Silicato di alluminio e solfuro di sodio  
 $2\text{Na}_2\text{Al}_2\text{Si}_2\text{O}_8 \cdot \text{Na}_2\text{S}_2$

ELEMENTO O IONE DA CONFERMARE:  
Sodio, Ione solfuro

#### STABILITÀ

ALLA LUCE: \*\*\*\*\*  
ALLA TEMPERATURA: \*\*\*\*\*  
ALL'UMIDITÀ: \*\*\*\*\*  
ALLA CALCE: \*\*  
CHIMICA: \*\*\*\*\*

FABBRICAZIONE: Aumentando la temperatura del forno durante la fabbricazione del Blu oltremare

BIBLIOGRAFIA: 66, 1, 19

EXHIBIT "A" Page 2 of 2

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